Docket No. 420-002 Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of	:	
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CHRISTOPHER S. NOLAN	:	Examiner Fox
	:	
Serial No.: 09/684,032	:	Group Art Unit 3652
	:	
Filed: October 6, 2000	:	
	:	
For: **LINER FOR CONTAINER WITH SIDE DOOR**	:	

RESPONSE TO RESTRICTION REQUEST

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Responsive to the Office Action dated April 5, 2005, requesting restriction of the claims in the above-identified application, Applicant elects claims 1-8 and 12-16 (Group I) with traverse.

As a preliminary matter, Applicant hereby petitions for a two month extension of time under 37 C.F.R. 1.136(a), and files herewith a USPTO form PTO/SB/22, therein extending the deadline for responding to September 5, 2005. Applicant authorizes the charge of any required fees from Deposit Account 11-0978.

The Action alleges that two independent "inventions" are claimed, and that the inventions of Group I (claims 1-8 and 12-16) and Group II (claims 9-11, 19, and 20) are

"related as process and apparatus for its practice." In this context, "apparatus" is synonymous with a "tool" for practicing a process. *Helifix Ltd. v. Blok-Lok Ltd.*, 54 USPQ2d 1299 (Fed. Cir. 2000) ("A process and apparatus (***tool***) for its practice can be restricted. . . .") (emphasis added). However, the liner of claims 1-8 and 12-16 ***is not an "apparatus" for practicing the process*** of claims 9-11, 19, and 20. Accordingly, the incorrect standard is applied, and the restriction of the claims is therefore improper.

Instead, these inventions are related as a product (the liner) and the method of using (installing) it. In that case, restriction is proper only if: (a) the process of using as claimed can be practiced with a materially different product; or (b) the product as claimed can be used in a materially different process. MPEP § 806.05(h) (8th ed. May 2004). Moreover, "the burden is on the examiner to provide an example" in support of a restriction request made pursuant to this section.

Moreover, Section 803 of the MPEP states that, "[i]f the search and examination of an entire application can be made without serious burden, the examiner ***must*** examine it on the merits, even though it includes claims to independent or distinct inventions." In this case, Applicant originally submitted its application with claims 1-8 covering a liner and claims 9-11 covering a method of installing a liner. In a first Office Action, the Examiner presented the results of his search and substantively addressed ***both*** the liner and the method claims, without any contention that the claims were directed to independent or distinct

inventions. ***The Examiner originally conducted the search and examination of the subject claims, so it has been implicitly admitted there is no serious burden.*** Accordingly, as stated in MPEP §803 above, the Examiner ***must*** examine the entire application on the merits.

As there is no legitimate basis for restricting the claims, Applicant respectfully requests examination of pending claims 1–20. If any matters require further attention, the Examiner is requested to contact Applicant's attorney at the telephone number below in order to expedite the prosecution of this patent application.

Respectfully submitted,

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Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on August 30, 2005

8/30/05